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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,041	02/12/2002	Marc Husemann	tesa AG 1523-WCG	7504
27386	7590	01/20/2004	EXAMINER	
WILLIAM GERSTENZANG NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			ASINOVSKY, OLGA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/075,041

Applicant(s)

HUSEMANN ET AL.

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Claims 1-6 and 13 are under examination.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 11 of copending Application No. 10/077,658. Although the conflicting claims are not identical, they are not patentably distinct from each other because the chemical formulation of the pressure-sensitive adhesive (psa) composition having an outgassing level preferably less than 10mg/g in claims 1, 2 and 11 of copending Application No. 10/077,658 is readable in the chemical formulation of a psa in the present claims. The rejection is set forth at pages 2-4 of the office action mailed on 08/07/2003. The applicants' comment has been considered.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11199832 or Pakusch et al U.S. Patent 6,552,116.
5. The rejections are set forth at pages 4-7 of the office action mailed on 08/07/02 and incorporated here by references.
6. Applicant's arguments filed on Nov. 07, 2003 have been fully considered but they are not persuasive.
7. The applicants' argument on JP'832 is that JP'832 does not teach that the composition has at least two-phase domain structure. JP'832 discloses a (meth)acrylic acid alkyl ester and monoethylenic unsaturated monomer copolymerizable with a said ester. The chemical formulation of the psa composition in JP'832 is disclosing at least two-phase structure. Reference does not disclose a process of making a psa. However, in the first step a methacrylic acid alkyl ester is polymerizing. It would have been obvious to one of ordinary skill in the art to consider that a monoethylenically unsaturated monomer is polymerizing in a separate phase from the polymerization of a (meth)acrylic ester monomer. The prima facie case of obviousness is that one of ordinary skill in the art would recognize that a copolymer comprising a polymerizable

(meth)acrylic ester and monoethylenic unsaturated monomer is a two-phase polymerization process.

8. The applicants' argument on Pakusch'116 is that reference does not disclose a pressure-sensitive adhesive composition. This argument is not persuasive. The chemical formulation of the composition in Pakusch is readable in applicants' claims. The composition in Pakusch can be used as a coating composition=paint, column 7, lines 15-17. It is well known that paint has an adhesive property. It would have been obvious to one of ordinary skill in the art to consider that upon the evaporation of water and solvent in the emulsion of the (co)polymer under the desired level, the resultant (co)polymer can be used as a pressure sensitive adhesive because the composition will retain the adhesive property, and, thereby, obtain a pressure-sensitive composition. It would have been obvious to one of ordinary skill in the art to consider that a (meth)acrylate ester-based composition in Pakusch invention has a low outgassing level since a said composition does not contain solvent.

9. Claims 1-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pakusch et al U.S. Patent 6,552,116 in view of Haak et al U.S. Patent 6,126,865.

10. Applicants' argument is that nothing in either Pakusch or Haak teaching a pressure-sensitive adhesive having a low outgassing level. The teachings in these references are not combined, since Pakusch does not disclose a pressure-sensitive adhesive and Haak does not disclose two-phase domain adhesive having a low outgassing level.

11. At least two-phase domain in a pressure-sensitive adhesive is readable in Haak' invention. Also, Haak does concern about outgassing level of the psa composition because the psa adhesive can be used for the computer applications, column 12, lines 11-13.

Pakusch and Haak disclose the analogous composition based on (meth)acrylic ester. The composition in Pakusch' invention has adhesive property. The composition are in the form of emulsion=latex. The level of water or solvent is controlling by the intended use of the composition. Pakusch discloses a coating=a water-based coating=paint composition without using organic solvent. In light of the disclosure in Haak the psa is prepared in the absence of solvent, column 10, line 18. The psa composition is not particularly moisture sensitive, column 11, lines 41-44, therefore, a psa can have a low outgassing level. It would have been obvious to one of ordinary skill in the art to consider that a multi-stage emulsion polymer in Pakusch' invention upon evaporation of water can be a pressure-sensitive adhesive having a low outgassing level in light of the teaching of Haak because Haak and Pakusch does not use organic solvent.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

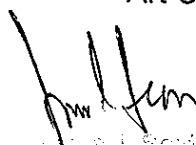
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

O.A.

O.A.  
January 08, 2004

Olga Asinovsky  
Examiner  
Art Unit 1711

  
James J. Seidleck  
Supervisory Patent Examiner  
Art Unit 1711